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UNITED STATES PATENT OFFICE.

APPEAL OF CLEVELAND HICKS

FROM

THE COMMISSIONER OF PATENTS.

STATEMENT OF THE COMMISSIONER, DEFINING "INTERLOCUTORY ACTIONS" AND "REJECTIONS."

D. P. HOLLOWAY,
COMMISSIONER.

WASHINGTON:
GOVERNMENT PRINTING OFFICE.
1885.

IN THE MATTER OF THE APPLICATION OF WILLIAM CLEVELAND HICKS FOR AN APPEAL FROM A DECISION OF THE COMMISSIONER OF PATENTS TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

UNITED STATES PATENT OFFICE,
Washington, May 21, 1864.

On a very careful consideration of the facts of the case in this proposed appeal, and of the law applicable thereto, having fully satisfied myself that such proposed appeal is without color or warrant of law, and that I have no authority or right to certify the same to the honorable Supreme Court of this District, I deem it proper to place on record for future proceedings in this office a statement of the reasons why, in my judgment, the desired appeal cannot be entertained as prayed for.

The facts of the case on which the question arises are, that a patent was granted to William Cleveland Hicks, dated the 10th day of March, 1857, for a certain improvement in breech-loading fire-arms; that on the 4th of February, 1864, the said Hicks surrendered his said patent and made application for the reissue thereof, under the terms of the thirteenth section of the act of July 4, 1830; that on looking into the said application for reissue it was found that four clauses of claim were drawn to improvements in the construction of the arm, and two clauses of claim to improvements in the cartridge to be used in such arm; whereupon the said applicant was informed by official letter dated February 15, 1864, that his said application was regarded as presenting a faulty duplicity of invention, contrary to the restriction of the twelfth section of the printed rules of this office, (which requires that "two or more distinct inventions should not be claimed under one application for letters patent;") that the said applicant, by letter dated February 16, 1864, in reply to the Commissioner, "declined both to cancel any part of the specification, and to make application for a divided reissue," and requested "that the case may be examined on its merits;" that the said applicant was informed by official letter dated February 19, 1864, that "the examination thereof is suspended until the requirement of a proper unity of subject-matter is complied with;" that the said applicant, by letter dated February 20, 1864, made "application for an appeal from the decision of the principal examiner in the above matter, and requested that the same may be heard by the honorable board of examiners-in-chief;" that the said applicant was informed by official letter dated March 28, 1864, that as his "said application had not been rejected by the examiner" it "was not in a condition for appeal to the examiners-in-chief" under the provisions of the law, and the former opinion

of the office must be "reaffirmed;" and that the said applicant, by petition dated April 29, 1864, made request of the Commissioner in the usual form "that an appeal may be allowed him from the decision of this Department," the said request presenting the said applicant's "reasons for appealing," and being accompanied with the petition of appeal to the honorable Supreme Court of the District of Columbia.

From the foregoing it will appear that the three above-mentioned letters, dated, respectively February 15, February 19, and March 28, 1864, which comprise the entire official correspondence in the case, (as is shown by the indorsement on the file thereof,) contain no *rejection* of the said application, nor anything analogous thereto. Not only has no opinion been expressed (even by the merest indirection) as to the novelty or admissibility of the said applicant's claims, but there is no intimation that even an *examination* of this point has been made, and, for all that appears to the contrary, the said applicant's six claims may be held to be entirely allowable, and even entitled to independent patents. On this state of facts, I proceed to consider the bearing of the several acts of Congress upon the question of the rights and limits of appeal from a decision of the Commissioner.

By the seventh section of the act of July 4, 1836, (Twenty-fourth Congress, session 1, chap. 357,) it is made the duty of the Commissioner, on the due filing of an application, (as prescribed by the section preceding,) to make or cause to be made an examination of the alleged new invention claimed in such application; and if it shall appear (1) that the applicant was not the first inventor thereof, or (2) that, being the first inventor, he had allowed it to be in public use or on sale previous to his application "for more than two years," or had otherwise "abandoned his invention to the public," (section 7, act of March 3, 1839, Twenty-fifth Congress, session 3, chap. 88,) or (3) that his invention was useless or trivial, or (4) that his exposition of his invention was incomplete and insufficiently communicative, it is the Commissioner's duty to refuse the application and notify the applicant of the grounds of his refusal, sufficiently to enable the said applicant to determine whether he will continue, modify, or abandon his application.

Besides these specified grounds for refusing the grant of letters patent, there is none other designated by any act of Congress. It plainly appears, therefore, that the Commissioner has no legal authority to *reject* an application for any other reasons than those actually enumerated. On the other hand, if it shall appear from the examination that the applicant *was* the first inventor, that he had *not* allowed his invention to go into public use, that his invention *was* sufficiently useful and important, and that he *did* completely and intelligibly describe the same, it is by the same seventh section made the duty of the Commissioner to issue a patent therefor.

It is perfectly obvious, however, that many conditions may exist in which the Commissioner is unable to either grant or refuse a patent

under the terms of the said seventh section. All the requirements of the sixth section of the act may have been literally complied with by the applicant, and all the conditions precedent stated in the seventh section may be fully satisfied by his application, and yet as manifestly it may be improper and impossible for the Commissioner to issue at once the patent, in the actual state of the application, without further action on the part of the applicant himself.

Thus, to employ a single illustration, the specification may have been written with a soft lead pencil, (and the statute does not direct it to be written otherwise,) or the duplicate drawings required may have been inscribed (with sufficient precision and clearness) on two wooden boards with a crayon of charcoal, or on two pieces of oil-cloth with a crayon of chalk, (and the statute does not prohibit such sketches,) in which case it is plainly the Commissioner's duty to suspend the issue, and inform the applicant in substance that his specification and drawings, as being altogether unfitted for durable preservation, could not be admitted; that they would be equally unsuitable either for continued reference among the official records or for exhibition in the patent, (of which one of his drawings must necessarily form a part;) and that for the benefit of future inventors, whose interests no less than his own are intrusted to the guardianship of the Commissioner, and for the needful convenience of the office itself in the discharge of the duties imposed upon it, his application (however patentable its subject-matter) would have to be postponed until he had furnished the office with proper and neatly executed papers.

In carrying out the various acts of Congress in relation to the subject of patents, and so administering the conduct of the Patent Office as most effectually to develop and realize the spirit of these enactments, (that is, in the exercise of his *executive functions*,) the Commissioner is properly and necessarily invested with a large range of discretionary power, responsible for any abuse of such ministerial discretion (as must be the case in every such deposit of trust) directly to his official superiors.

For the convenient administration of the high and responsible duties of his office; for securing an equitable unity of action in its various departments, and a uniformity of process and of presentation of papers and exhibits from its suitors; for providing most effectually for the good condition and ready preservation of its all-important records of inventions; for facilitating the onerous and important business of examination required by law to be made into the originality or pre-existence of alleged inventions; for the avoidance of needless controversies with querulous or exacting petitioners, (fortunately very few in number,) and for advancing the individual and related interests of applicants themselves, established "rules and directions," well considered, publicly announced, and judiciously enforced, are *indispensable*.

Such a system of regulations, adopted and administered by every

Commissioner from the organization of the Patent Office, (with such modifications and additions as successive experiences have suggested,) has continued to govern, no less the official action than the proceedings of applicants to the present time—regulations which, in no just sense, can be accounted as really impairing any equitable rights, and which certainly do not contravene in any respect the liberal provisions of the law for the encouragement and protection of inventors.

It is in the execution and maintenance of the "rules and directions for proceedings in the Patent Office" that a very considerable portion of the official correspondence is employed. From the ignorance of many applicants as to the real character of these requirements, and the inadvertence of others who design to faithfully observe them; from the inability of some to appreciate the importance of general rules, and the impatience of restraint felt by others—through caprice or the sentiment of some accidental or temporary inconvenience in obedience to law or system—the various restrictions upon the negligent or imperfect writing of the specification; upon the size, materials, and character of the drawings; upon the extent or the sufficiency of the model; upon the nature and methods of amendments; upon the inclusion of separate inventions in a single application, and numerous other specific incidents not directly provided for by the acts of Congress, and which restrictions are intended to define more precisely the manner in which inventors should avail themselves of the benefits of those acts, furnish constant subjects of correspondence, and sometimes of prolonged discussion, between the applicant and the office. When from a stubborn and willful disregard of the deliberately settled and clearly expressed directions of the office a claimant refuses to place his application in such a condition that it can, in the view of the Commissioner, be properly ordered to issue or examined to that end, the latter has no resource but to inform the applicant that the further consideration of his case is suspended until the official requirement is complied with.

By the uniform practice of the office from its earliest days, all such applications, whatever be the nature of this "intermediate" action upon them, are distinguished as "postponed" cases, are technically accounted as "new" cases, (however long they may have been on file in the office,) in opposition to "return" cases, or those which have been actually *rejected;* are kept by the draughtsman (who is the official custodian of all application files) in a separate depository from such "rejected" cases, and have their drawings preserved in a different class of portfolios from those appropriated to "rejected" drawings.

It has appeared proper and necessary to say thus much, and to so dwell upon these apparently unimportant particulars, in order to exhibit as clearly as possible the distinction which has ever been observed in this office between a "final" and an "intermediate" action, between a decision on the patentable merits of an invention (under the requirements of the seventh section of the act of 1836) and what may be called

an "interlocutory judgment" on its form of presentation, (under the office rules;) in short, between a refusal to *grant a patent* and a postponement of the examination. By the same section of the act of 1836, which prescribes the Commissioner's duty and defines his authority to deny a patent, it is further provided that if upon a reconsideration of an application rejected by him (in whole or in part) he is still of opinion that the dissatisfied applicant is not entitled to a patent, (even upon amendatory and restricted claims,) the said dissatisfied applicant may thereupon, on written appeal, have the decision of a "board of examiners," (consisting of three competent and disinterested persons to be appointed by the Secretary of State, and to act under oath,) who are authorized, on a full and impartial review of such adverse opinion and decision of the Commissioner, to affirm or reverse, in whole or in part, the Commissioner's said decision.

It appears too obvious for comment that this appellate jurisdiction of the "board of examiners," full and complete as it is made over all the questions specified in the said seventh section, can by no reasonable construction of law be extended to any other questions which may arise between the applicant and the office. The special requirement that the said "board of examiners" shall be furnished with a written certificate from the Commissioner, "stating the particular grounds *of his objection* and the part or parts of the invention *which he considers not entitled* to be patented," seems to preclude a rational question of this position. By the following or eighth section of the same act the decision of the Commissioner in interference trials between rival applicants (which by a clear construction falls within the class of refusals embraced by the seventh section) is also—for the avoidance of a possible doubt—expressly made amenable to the same appellate jurisdiction. *No other case of decision by him is by any law included in the category of appealable judgments.*

By the eleventh section of the act of March 3, 1839, (Twenty-fifth Congress, session 3, chap. 88,) it is enacted "that in cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners provided for in the seventh section of the act to which this is additional, the party *instead thereof* shall have the right to appeal to the Chief Justice of the District Court of the United States for the District of Columbia," which in precise terms transfers to the Chief Justice of the District the same appellate jurisdiction (*and no more*) previously vested in the board of examiners. By the first section of the act of August 30, 1852, (Thirty-second Congress, session 1, chap. 107,) the same appeal "may also be made to either of the assistant judges" of the said court.

By the third section of the act of March 3, 1863, (Thirty-seventh Congress, session 3, chap. 91,) organizing the "Supreme Court of the District of Columbia," it is enacted that the said court "shall possess the same powers and *exercise* the same jurisdiction as is now possessed and

exercised by the Circuit Court of the District of Columbia, and the justices of the court so organized shall *severally* possess the powers and *exercise the jurisdiction* now possessed and exercised by the judges of the said Circuit Court;" which again transfers the same *appellate jurisdiction* over the Commissioner's decisions (*and no more*) resident in the preceding tribunals, respectively.

This comprises the history of the legislation of Congress on the subject of appeals from a decision by the Commissioner; and it will be plainly seen that in no case throughout this history is an appeal provided for any other decision than one expressly refusing the grant of a patent.

If any confirmation were needed of a position which appears to be so necessary a construction of the statutes covering the subject, it is abundantly afforded in repeated judicial decisions upon this very point.

In the matter of Edwin Janney's appeal from a decision of the Commissioner of Patents, Commissioner Burke, in presenting the case, responded to the reasons of appeal by urging that his official act in refusing to consider a case in a certain condition of facts was "not a *judicial* but an executive act," and that therefore it was "not an act of which the honorable Chief Justice has jurisdiction." And, again, that as "the decision in this case does not *refuse* letters patent for the alleged invention, but simply refuses to again take up and examine the alleged invention," for this reason it was not appealable under the law, and not within the jurisdiction of the court.

Chief Justice Cranch, in his decision rendered December 14, 1847, held that "inasmuch as the decision of the Commissioner from which the appeal is taken neither affirms nor denies the right of the appellant to the patent (which he claims) upon the merits of the supposed invention, it is not such a decision as is the subject of appeal under the act of July 4, 1836, 'to promote the progress of the useful arts,' &c., or the act of March 3, 1839, in addition to that act, and that, therefore, I have not jurisdiction of this appeal, which is therefore hereby dismissed." (Recorded in "Book of Appeals" No. 1, page 220.)

In the matter of the appeal from a decision of the Commissioner by *Horace D. Wade, appellant*, v. *Moses M. Mathews, appellee*, it was contended by Mr. Burke, of counsel for the appellee, that by the act of 1836 there were but "four grounds on which the Commissioner was authorized to refuse a patent; and it was *to these points alone* that the revision of the board of examiners was confined," "and therefore, inasmuch as the same jurisdiction, and that only, which the board of examiners possessed was transferred by the eleventh section of the act of March 3, 1839, to the judge, he cannot embrace in his review of the decision of the Commissioner any other matters than those which were legally cognizable by the board of examiners." "Congress, in giving him jurisdiction over the decisions of the Commissioner of Patents in certain specified cases on appeal, (which must be his ultimate, not interlocutory, de-

cision,) never contemplated giving him unlimited power over the acts of the Commissioner, thus making the judge himself, in fact, the Commissioner of Patents."

It was held by Chief Justice Cranch (in his decision rendered September 4, 1850) that, as regarded the subjects of the appellant's first, second, third, fourth, fifth, sixth, and seventh reasons of appeal, "they were matters within the discretion of the Commissioner, and over which the judge had no control nor jurisdiction, these matters not having been made the subjects of appeal nor valid grounds of appeal." And, again, in regard to questions embraced in the appellant's ninth reason of appeal, "these were matters for the consideration and within the discretion of the Commissioner, until the patent should be finally issued, and are not made the subject of appeal. *Nothing preliminary* to (the question of) the issuing of the patent *is a valid ground of appeal*, unless made so by the law." (Recorded in "Book of Appeals" No. 1, page 403.)

It may appear calculated to weaken the force of what, in its simple presentation, is so direct and conclusive, to urge any additional consideration upon the subject; but there is another application of law to the question no less clear and decisive, and which is so pertinent to this point that I cannot forbear presenting it, even at the risk of some prolixity.

It was enacted by the second section of the act of March 2, 1861,(Thirty-sixth Congress, session 2, chap. 88,) "that for the purpose of securing greater uniformity of action *in the grant and refusal of letters patent*," (not in the execution of the Commissioner's rules and directions, but) "*in the grant and refusal of letters patent*, there shall be appointed by the President, by and with the advice and counsel of the Senate, three examiners-in-chief," "whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners *when adverse to the grant of letters patent*, and also to revise and determine in like manner upon the validity of the decisions of examiners *in interference cases*," (being "governed in their action by the rules to be prescribed by the Commissioner of Patents,") and "that from their decision appeals may be taken to the Commissioner of Patents in person."

In this somewhat anomalous provision for an "appeal" *within* the Patent Office (and against itself) it will be observed that precisely the same class or classes of cases are expressly designated as have been shown to be embraced within the provisions of the seventh section of the act of 1836 for an appeal *without* the office, and that no other class of cases or of actions by the examiner has been so designated.

In the matter of the appeal from a decision of the Commissioner by *Thomas Snowden*, *appellant*, v. *Ephraim Pierce*, *appellee*, Chief Justice Dunlop, in his decision rendered June 25, 1861, held that "under the act of 2d of March, 1861, the primary examiners and the examiners-in-chief are, by the terms of the act, recognized as *judicial officers* acting

independently of the Commissioner." "The Commissioner, under this act of March, 1861, can give no judgment till the *appeal* reaches him, and this cannot be done till the judgment of the primary examiner has first been submitted to the examiners-in-chief. The judges of the Circuit Court of the District of Columbia, *by law*, can entertain no appeal except from the decision of the Commissioner." "It follows, therefore, that no judgment now in any patent case, of the character above described, can be given by the Commissioner till it reaches him in due course by appeal; that is to say, the applicant must go from the primary examiner by appeal to the examiners-in-chief, and from them by appeal to the Commissioner, and lastly from the Commissioner to the judges of the Circuit Court."

"This appeal to the judges still exists; *but it can only be exercised after the applicant has gone the rounds of all the tribunals created by the new law, and after the final decision of the Commissioner.*" (Recorded in "Book of Appeals" No. 3, page 469.)

Now, it necessarily results from this application of the new law of 1861 that if the examiner does not *reject* an applicant—that is, if he does not expressly *refuse him a patent*, (on the whole or on a part of his specification of claim)—there is not provided by said act any appeal from his decision to the "examiners-in-chief." In any preliminary or intermediate action he may take on an application before him (as upon a consideration of the observance or non-observance of the official rules in the presentation of the application) the examiner can only be regarded as acting in his *ministerial* capacity, and immediately under the authority of the Commissioner, precisely as he always has acted since the existence of his office. It is clearly only in the specified case of a final *rejection* of an application (or of an adverse decision in an interference suit) that he can be considered as vested with this "independent" *judicial* character assigned him in the above-cited decision upon the force and intendment of the law. And this "judicial" act of rejection can as clearly be properly exercised by him *only* under the legal warrant of the provisions of the seventh section of the act of 1836.

But if the examiners-in-chief, under the said second section of the recent act of 1861, have no appellate jurisdiction over the judgments or proceedings of the examiners, (*excepting* in the specified instances of a judicial decision by him *adverse* to the grant of a patent,) it is equally clear by the opinion of Chief Justice Dunlop above quoted that the same exception unavoidably attaches to the appellate jurisdiction of the Commissioner himself, and, by an equally inevitable logic, to that of the "Circuit Court of the United States for the District of Columbia," or its immediate successor, the "Supreme Court of the District of Columbia."

I must, therefore, most confidently hold that there is no authority of law for this proposed appeal of Mr. Hicks from my decision of March 28, 1864, since it is not such a decision as is particularly specified in the

said second section of the act of 1861, and for the obtaining of which a special fee of $20 is by the tenth section of the same act required to be paid into the office. So far from the applicant in this case having "complied with the requirements of the several acts of Congress," as alleged by him in his petition of appeal, filed April 29, 1864, (which requirements form the conditions precedent on which alone an appeal can be entertained,) there has been *no* preceding appeal taken in this matter "to the Commissioner of Patents in person," and *no* fee of $20 has been paid into the office for any such appeal, as required by the said second and tenth sections of the act.

Were it possible by ingenious suggestions of fitness or of propriety, of supposed expediency or of fancied analogies, to avoid the force of this significant exclusion from appeal of all other than "final" actions of the examiner, such attempted avoidance is utterly frustrated by the absolute and explicit prohibition of the third section of the said act of 1861, "that *no appeal shall be allowed* to the examiners-in-chief from the decisions of the primary examiners (except in interference cases) *until after the application shall have been twice rejected.*"

Here, then, we have a conclusion of question. Here is the positive *interdiction* of all appeals from any preliminary or "intermediate" determination of the examiner—whether in the first resort, to the examiners-in-chief, or in the third resort, to the Supreme Court of the District of Columbia.

As it is thus fully established that the present applicant, never having been *rejected* by me, has no grounds of appeal under the existing provisions of the law; that this interpretation, so far from being doubtful, has received the deliberate and iterated sanction of the honored Chief Justice before whom alone such an appeal could have been considered, and is therefore a *res judicata*—nay, that the said applicant is not only excluded from any legal right of such procedure, but that by more recent legislation he is expressly prohibited therefrom—it becomes unavoidably my duty, and is the only proper course left me, to refuse the admission of the appeal, and to decline submitting the same to the honorable Supreme Court of the District of Columbia.

D. P. HOLLOWAY,
Commissioner of Patents.

(Recorded in vol. 9, page 323, Com'r Decisions.)

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